

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

TARBELL et al.

Atty. Ref.: PTB-4942-5

Serial No. 10/531,260

Confirmation No.: 4670

TC/A.U.: 2164

Filed: April 13, 2005

Examiner: Yuk Ting Choi

For: METHOD, SYSTEM AND SOFTWARE FOR JOURNALING
SYSTEM OBJECTS

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April 3, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 CFR §1.182

Applicants received a Notice of Panel Decision from Pre-Appeal Brief Review which indicates that Applicants Pre-Appeal Brief Request for Review filed on March 10, 2009 is improper since it includes a “proposed” Amendment. This Petition is being filed to request the Patent Office to consider Applicants Pre-Appeal Brief Request for Review on the merits, based on the Statement of Arguments filed on March 10, 2009.

Applicants Pre-Appeal Brief Request for Review was filed with the requisite Notice of Appeal and Statement of Arguments. In addition, to obviate various issues, an Amendment After Final Rejection was filed before the filing of the Pre-Appeal Brief Request for Review in which dependent claims 92 and 93 were canceled. This Amendment was entered in the Advisory Action issued by the Examiner on March 18, 2009.

The Notice of Panel Decision issued on March 30, 2009, i.e., after the Amendment was entered. Thus, to the extent that the Amendment After Final Rejection included a “proposed” Amendment, that proposed Amendment was already entered at the time that the Notice of Panel Decision was entered. Moreover, the Amendment After Final Rejection is not properly

considered a "proposed" amendment since the only amendment included the cancellation of claims, which Applicants are entitled to entry of as a matter of right. Specifically, the entry of an amendment to cancel claims simply reduces issues for appeal. In addition, the arguments in the request apply regardless of whether the Amendment was entered.

Moreover, Applicants refer to the attached portion of an OG Notice dated July 12, 2005, specifically the section "What actions will terminate the panel's review?" That section indicates that an after-final amendment filed after the filing of the request will terminate review. However, in the present case, the after-final amendment was filed electronically before the request. This constitutes yet another reason why the termination of the request was improper.

Accordingly, Applicants respectfully request that the Statement of Arguments in support of the Pre-Appeal Brief Request for Review be considered on its merits.

Applicants believe that no fee is required for consideration of this Petition as the premature termination of the conference was improper, however, should the U.S. Patent and Trademark Office determine otherwise, authorization is hereby granted to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 14-1140 referencing docket number (PTB/4942-5).

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____ /Paul T. Bowen/
Paul T. Bowen
Reg. No. 38,009

PTB:jck
Attachment: OG Notice
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Telephone: (703) 816-4000
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If the applicant feels the rejections of record are clearly not proper and are without basis, then filing this request may result in a panel decision that eliminates the need to file an appeal brief. This should be based upon a clear legal or factual deficiency in the rejections rather than an interpretation of the claims or prior art teachings. The latter is more appropriate for the traditional appeal process currently employed by applicants.

. What happens during a panel review?

A panel of examiners (including the examiner of record) will consider the merits of each ground of rejection for which appeal has been requested and will issue a written decision as to the status of the application.

. When should you file an appeal brief or other correspondence?

This program is designed to allow applicants who think there is a clear deficiency in the *prima facie* case in support of a rejection to file the request at the same time that they file a notice of appeal. This affords the Office the best opportunity to ensure that applicant will promptly receive a decision on the request. If the request is filed with the notice of appeal, the period of time for filing the appeal brief will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request.

. What actions will terminate the panel's review?

If applicant files any of the following responses after filing a request, but prior to a decision by the appointed panel of examiners assigned to conduct the review, the review process will end and a decision will not be made on the merits of the request:

- an appeal brief
- a request for continued examination (RCE)
- an after-final amendment
- an affidavit or other evidence
- an express abandonment

A request for the declaration of an interference will also result in an end to the review process. Applicant will be promptly notified by an Office communication of termination or of dismissal of the request. If any of the above-noted actions occur, the period for filing the appeal brief (if applicable) will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request.

2. Conditions Necessary to Request a Panel Review:

- Applicant must file a notice of appeal in compliance with 37 CFR 41.31.
- Applicant must file the request with the filing of a notice of appeal and before the filing of an appeal brief. 1

3. Content of Request:

- a. File the request and accompanying arguments in a separate paper entitled, "Pre-Appeal Brief Request for Review". A sample request form has been created and is available on the USPTO Internet Website, on the forms page, as PTO/SB/33.